

REMARKS

Applicant has studied the Office Action dated September 26, 2006. Claims 20-22, 25-28 and 30-32 are pending. Claims 20 and 30-32 are independent claims.

It is submitted that the application is in condition for allowance. Reconsideration and reexamination are respectfully requested.

§ 102 Rejections

Claims 20, 21, 25-27 and 30-32 were rejected under 35 U.S.C. § 102(b) as being anticipated by Takahashi et al. ("Takahashi" U.S. Patent No. 6,483,983). Applicant respectfully disagrees with the Examiner's interpretation of Takahashi and traverses the rejection.

It is respectfully noted that a proper rejection for anticipation under § 102 requires complete identity of invention. The claimed invention, including each element thereof as recited in the claims, must be disclosed or embodied, either expressly or inherently, in a single reference. Scripps Clinic & Research Found. v. Genentech Inc., 927 F.2d 1565, 1576, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991); Standard Havens Prods., Inc. v. Gencor Indus., Inc., 953 F.2d 1360, 1369, 21 U.S.P.Q.2d 1321, 1328 (Fed. Cir. 1991).

It is respectfully noted that independent claims 20 and 30-32 recite storing thumbnail pictures in a menu data area of a recording medium. As illustrated in FIG. 6 of the specification as originally filed, actual thumbnail pictures are stored in the recording medium as a block of data. On the other hand, it is respectfully submitted that Takahashi fails to disclose storing thumbnail pictures in a menu data area of a recording medium, but rather discloses storing **full-size images** on a recording medium that are only reduced upon reproduction and display.

It is respectfully noted that Takahashi is directed to a "method and apparatus for recording picture information on a recording medium." Col. 1, ll. 9-17. As such, it is respectfully submitted that the disclosure contained in Takahashi is directed to the apparatus that records the information rather than to the "recording medium" on which

the information is recorded.

It is further respectfully noted that Takahashi discloses a "function for diminishing or reducing the size of picture for display upon decoding of the picture signal. Col. 4, ll. 34-37. Therefore, it is respectfully submitted that Takahashi discloses the reduction of non-thumbnail "picture data" stored on a recording medium such that the "reduced screen picture data" may be displayed rather than storing the "reduced screen picture data," or thumbnail pictures, on a recording medium, as evidenced by the process disclosed at Col. 6, ll. 1-51 and steps S45-S47 of FIG. 4 during which the "driver unit 1 starts reproduction of the information... of the disk" and the "decoder unit 3 reduces the picture represented by the reproduced signal" in order to "place the corresponding reduced screen picture data in the display-destined picture storage area 401."

It is respectfully noted that the Examiner asserts, at paragraph 1 on page 2 of the Office action, that Takahashi discloses an embodiment wherein a user may create/select thumbnail images to be used for the DVD menu system (column 12, lines 7-62). These images are specifically disclosed as being stored on the recording data storage area, 123, with all the other data (see Fig. 7; column 9, lines 7-51 and column 12, lines 7-62." Applicant respectfully disagrees with the Examiner's interpretation of the cited portion of Takahashi, which is specifically the "fifth embodiment."

Fifth Embodiment of Takahashi

Applicant first respectfully directs the Examiner's attention to a first portion of the "fifth embodiment" of Takahashi to which he referred, specifically col. 12, ll. 7-11. It is respectfully noted that col. 12, ll. 7-11 disclose "a fifth embodiment of the invention is directed to ... the **representative reduced picture** of a stream is a **still picture or a character image** created separately by the user on a stream-by-stream basis and **recorded on a disk**." (emphasis added) Applicant respectfully submits that the disclosure is misleading if taken by itself in that it is ambiguous as to whether the phrase "recorded on a disk" refers to "the representative reduced picture" as the Examiner apparently has interpreted it or to the "still picture or character image." Applicant further

respectfully submits that the disclosure following col. 12, ll. 7-11 as well as other disclosure in Takahashi makes it clear that the phrase "recorded on a disk" refers to the "still picture or character image," which is not a thumb-nail image, rather than to the "the representative reduced picture."

Applicant next respectfully directs the Examiner's attention to a second portion of the "fifth embodiment" of Takahashi to which he referred, specifically col. 12, ll. 12-16. It is respectfully noted that col. 12, ll. 12-16 disclose "The still picture can be generated by using a video camera set to the still mode or by a camera dedicated only for taking still pictures (e.g. electronic still camera), a scanner, or the like, whereas the character image can be generated by inputting relevant data by means of a keyboard." It is further respectfully noted that there is no disclosure of any reduction of the "still picture" or "character image" such that a thumbnail image is created nor is there disclosure that the "video camera," the "camera dedicated only for taking still pictures" or the "scanner" is adapted to create thumbnail images.

Applicant finally respectfully directs the Examiner's attention to a third portion of the "fifth embodiment" of Takahashi to which he referred, specifically col. 12, ll. 33-44. It is respectfully noted that col. 12, ll. 33-44 disclose "Subsequently, data reproduction from the disk is performed through the procedure described hereinbefore in conjunction with the **second embodiment** of the invention, to thereby display a selection enable picture array for the picture program of concern, whereon **a reduced picture of the stream of interest is selected.**" (emphasis added). It is respectfully noted that the disclosed "fifth embodiment" of the Takahashi to which the Examiner refers is identical to the "second embodiment" of Takahashi with regard to the "data reproduction from the disk." Applicant has discussed the "second embodiment" in the response to the previous Office action and again respectfully submits that the "second embodiment" of Takahashi discloses that "reduced picture", or thumbnail pictures, is not stored on a recording medium, as recited in the claims of the present invention, but rather that "reduced screen picture data" is stored in "the display-destined picture storage area 401."

Second Embodiment of Takahashi

Applicant first respectfully directs the Examiner's attention to col. 9, ll. 39-42. It is respectfully noted that that col. 9, ll. 39-42 disclose, "the data stored in the recording data storing area 123 are used to execute the processing steps S41 to S51, whereby the picture or program of interest can be selected." It is respectfully submitted that this disclosure is related to selecting the "picture or program of interest" that is stored on the disk, with the non-thumbnail "picture or program of interest" then subjected to "processing steps S41 to S51" during which the "reduced picture" is generated.

Applicant next respectfully directs the Examiner's attention to step "S47" of FIG. 4, col. 4, ll. 51-55, col. 6, ll. 40-51 and FIG. 1. It is respectfully noted that step "S47" of FIG. 4 discloses "REDUCE START PICTURE m-th CHAPTER AND STORE IT IN DISPLAY-DESTINED AREA 401." It is further respectfully noted that col. 4, ll. 51-55 disclose "RAM 4 is provided with a display-destined picture storage area 401" and FIG. 1 discloses "RAM 4" as part of the "reproducing apparatus." Moreover, it is respectfully noted that col. 6, ll. 40-51 disclose "decoder unit 3 reduces the picture represented by the reproduced signal to thereby store or place the corresponding reduced screen picture data in the display-destined picture storage area 401." It is respectfully submitted that the "reduced screen picture data" is stored in the "display-destined picture storage area 401" as opposed to the "recording data storage area 123" as asserted by the Examiner.

Interpretation of Disclosure Related to Fifth Embodiment of Takahashi

In view of the aforementioned additional disclosure related to the "second embodiment" and "fifth embodiment" of Takahashi, it is respectfully submitted that the phrase "recorded on a disk" at col. 12, line 10 clearly refers to the "still picture or character image" as opposed to the "representative reduced picture." It is further respectfully submitted that the "still picture or character image" that is "recorded on a disk" is clearly not a thumbnail image, given that the reduction disclosed in Takahashi

that produces the asserted thumbnail image takes place after the "still picture or character image" is "recorded on a disk." Moreover, it is respectfully submitted that the proper interpretation of col. 12, ll. 7-62 of Takahashi is that non-thumbnail images are recorded on the disk and then reduced picture data is generated, according to the second embodiment, with the reduced picture data stored in a display-destined storage area.

Therefore, it is respectfully asserted that independent claims 20 and 30-32 are allowable over the cited reference. It is further respectfully asserted that claims 21 and 25-27, which depend from claim 20, also are allowable over the cited reference.

§ 103 Rejections

Claims 22 and 28 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Takahashi in view of Chen et al. ("Chen" U.S. Pat. No. 5,917,830). This rejection is respectfully traversed.

It is respectfully noted that the Federal Circuit has provided that an Examiner must establish a case of prima facie obviousness. Otherwise the rejection is incorrect and must be overturned. As the court recently stated in In re Rijkaert, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993):

"In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. Only if that burden is met, does the burden of coming forward with evidence or argument shift to the applicant. 'A prima facie case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art.' If the examiner fails to establish a prima facie case, the rejection is improper and will be overturned." (citations omitted.)

It is respectfully submitted that Chen fails to cure the deficiencies of Takahashi with respect to storing thumbnail pictures in a menu data area of a recording medium, as recited in independent claim 20. Therefore, it is respectfully asserted that independent claim 20 is allowable over the cited combination of references, as are

claims 22 and 28, which depend from claim 20.

CONCLUSION

In light of the above remarks, Applicant submits that the claims 20-22, 25-28 and 30-32 of present application are in condition for allowance. Reexamination and reconsideration of the application, as amended, are requested.

No amendment made was related to the statutory requirements of patentability unless expressly stated herein; and no amendment made was for the purpose of narrowing the scope of any claim, unless Applicant has argued herein that such amendment was made to distinguish over a particular reference or combination of references.

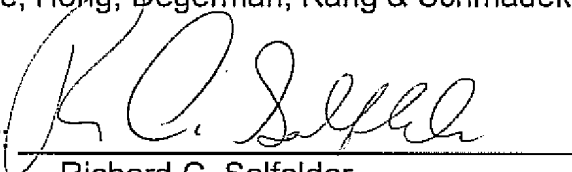
If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at the Los Angeles, California, telephone number (213) 623-2221 to discuss the steps necessary for placing the application in condition for allowance.

Respectfully submitted,

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